UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,739	11/13/2003	Indran Naick	AUS920030777US1(4016)	2701

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EXAMINER
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ART UNIT	PAPER NUMBER
2142	

NOTIFICATION DATE	DELIVERY MODE
07/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *28 April 2008*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3,4,8-10,12,13,15-18,20 and 24-32* is/are pending in the application.

     4a) Of the above claim(s) *24-32* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 3, 4, 8-10, 12, 13, 15-18, 20, and 23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some *   c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 24-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 28, 2008.

Response to Arguments

Applicant's arguments with respect to the rejection(s) of claim(s) 1, 3, 4, 8-10, 12, 13, 15-18, 20, and 23 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 12, 13, 15-18, 20, and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10, 12, 13, and 15-17, read in light of the instant specification, may be reasonably construed to cover embodiments which consist entirely of software. See [0015]. Software *per se* is not statutory subject matter. See MPEP 2106.01.

Claims 18, 20, and 23 are directed to a "machine-accessible medium." According to the

instant specification, a "machine-accessible medium" may be reasonably construed to cover

carrier waves and the like (see [0050]). Absent a structurally and functionally interrelated

medium employed as a computer component, machine instructions are not statutory subject

matter. See MPEP 2106.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 3, 4, 9, 10, 12, 15, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942).

Regarding claim 1, Beyda shows a method for employing private content (recipient-

specific comments: see col. 3, lines 3-7) in an email message for recipients, the method

comprising:

- receiving, at an email server (message processor 20), the email message addressed

   to the recipients from an email client (see col. 2, lines 40-51 and col. 3, lines 28-

   32);

- identifying, by the email server, in response to receipt of the email message from the email client, an instance of the private content in the email message (see col. 3, lines 33-37);

- determining, by the email server, an association between the instance and a recipient of the recipients (step 72: see col. 3, lines 46-53);

- generating, by the email server, an email for the recipient based upon determining the association, the email comprising the email message with the instance (steps 76 and 78: see col. 3, lines 55-59);

- generating, by the email server, one or more additional emails for the one or more remaining recipients, wherein generating the one or more emails comprises redacting the email message to exclude the instance (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), wherein a redacted email message is created (comprising an email without comments), and generating the one or more additional emails with the redacted email message to display the email message with the instance when routed to the recipient (note that the message would display the instance since it is included in the message: see step 78) and to exclude the instance when routed to the one or more remaining recipients (see step 74); and

- transmitting, by the email server, the emails to the recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda does not explicitly show that associations are determined in response to identifying instances.

Gilbert shows an email server determining associations between instances of content and recipients in response to identifying the instances (see col. 8, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the responsive determination of Gilbert in order to avoid wasting time determining associations when there are no instances of a particular kind of content in an email message.

Regarding claim 3, the combination further shows wherein identifying the instances comprises identifying a mark adjacent to the instance, wherein the mark is indicative of a bounding edge of the instance (see Gilbert, col. 4, lines 16-21 and col. 8, lines 1-16).

Regarding claim 4, the combination further shows wherein identifying the instance comprises identifying the instance as a highlighted portion of text in response to a command from a user (see Gilbert, col. 6, lines 38-47).

Regarding claim 9, the combination further shows wherein redacting the email message to exclude the instance comprises deleting the instance from the email message (note that before redacting, the comments are in the message of Beyda, and after redacting, the message contains only the common content: see col. 3, lines 3-7 and 53-55).

Regarding claim 10, Beyda shows an apparatus (mail processor 20) for employing private content in an email message for recipients, the apparatus being part of an email server (see col. 2, lines 40-51) and comprising:

- a content identifier to receive the email message from an email client (see col. 2, lines 40-51 and col. 3, lines 28-32) and, in response, to identify one or more instances of private content in the email message (see col. 3, lines 33-37);

- a content associator to determine an association between at least one instance and a first set of one or more of the recipients (step 72: see col. 3, lines 46-53);

- an email generator to generate a first email for each recipient in the first set comprising at least one instance based upon an association with the at least one instance (steps 76 and 78: see col. 3, lines 55-59) and to redact the at least one instance from the email message to generate emails for additional sets of recipients (step 74, comprising transmitting only the common portion: see col. 3, lines 53-55), if any, to display the email message with the at least one instance when routed to the first set of one or more recipients (note that the message would display the instance since it is included in the message: see step 78) and to exclude the at least one instance when routed to other recipients (see step 74); and

- a messaging gateway coupled with the email generator to transmit the emails to the recipients (steps 74 and 78: see col. 3, lines 53-59).

Beyda does not explicitly show associating remaining instances, if any, with additional sets of recipients.

Gilbert shows associating multiple instances of content in an email with multiple sets of recipients (see Fig. 5 and col. 8, lines 8-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Beyda with the multiple instances and additional sets of recipients taught by Gilbert in order to provide increased flexibility when composing messages to diverse groups.

Claim 12 corresponds to claim 3 and is rejected for the same reasons as given above.

Regarding claim 15, the combination further shows wherein the content associator is configured to generate an index associating the first set of the recipients with at least one location of one or more instances in the email message (see Gilbert, col. 5, lines 6-25).

Claim 17 corresponds to claim 9 and is rejected for the same reasons as given above.

Claims 18 and 20 correspond to claims 1 and 3 and are rejected for the same reasons as given above.

Claims 8, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Rafal (US Pub. No. 2002/0002586).

The combination shows the limitations of claims 1, 10, and 18 as applied above, and

further shows displaying the instance in response to routing the email to the recipient

(necessarily the case, as the instance is included in the email: see Beyda, col. 1, lines 59-67).

The combination does not show using hypertext markup language code to display the

instance.

Rafal shows using hypertext markup language code to display email content (see [0037]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

further modify the system of Beyda with the HTML code taught by Rafal in order to provide for

text formatting in the email.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US Patent

No. 6,636,965) in view of Gilbert (6,529,942), and further in view of Altavilla (US Pub. No.

2002/0194280).

The combination shows the limitations of claim 10 as applied above, but does not show

wherein the content identifier is configured to parse a table, wherein the table identifies a

location of the instance in the email message.

Altavilla shows parsing a table, wherein the table identifies a location of an instance of

content in an email message (the table comprising a set of tags attached to recipients: see Fig. 3

and [0025]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to further modify the system of Beyda to use a table as taught by Altavilla in order to associate

recipients with appropriate instances of content without inserting markup into the email body.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743.

The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Andrew Caldwell/
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